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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,267	11/17/2003	Finis Conner	021206-000710US	6476

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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,267

Applicant(s)

CONNER ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 8 and 15 is withdrawn in view of the newly discovered reference(s) to Yagi et al. (US 2004/0104469) and Shimazaki et al. (US 2002/0060969). Rejections based on the newly cited reference(s) follow.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification (page 5) recites the pin is in the reader, whereas claim 15 recites that pin is in the card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 8-10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yagi et al. (US 2004/0104469) in view of Opheij et al. (cited in the previous Office Action).

Yagi et al. teaches a card having a width, length and thickness (abstract), a storage medium to store data (flash memory 115), an integrated circuit device (IC 114), and that the IC is provided directly over the flash memory (abstract). Yagi et al. teaches a circuit interface provided between the IC and flash memory (abstract). Though silent to the interface being a flexible circuit, the Examiner interprets the interface as flexible as it connects both memory and IC together. Though silent to being physically flexible, the Examiner notes it would have been obvious to one of ordinary skill in the art to have a flexible circuit in order to have some resistance to stress/bending that the card might be subject to in use.

Yagi et al. is silent to the ratio of length to thickness being at least 5:1 and that the IC includes security information used to authenticate a request to access the storage medium. However, the Examiner notes that as Yagi et al. is drawn towards small sized cards, it would have been obvious to one of ordinary skill in the art to have the 5:1 ratio, in order to have a small card medium, able to be used in conventional reading/processing devices, but that has expanded memory since the modules are mounted on both sides. The Examiner also notes that cards of such a ratio (including memory and smart cards) are well known and conventional for portability and convenience.

Opheij et al. teaches an integrated circuit device including security information (2, 20 that include a PIN) used to authorize a request to a storage medium. The Examiner additionally notes that storing security data in the IC to access memory (upon authentication/verification) is well known and conventional in the art for security purposes. Additionally, it is obvious that the ratio of Opheij et al. is at least 5:1 (length to thickness).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Yagi et al. with those of Opheij et al.

One would have been motivated to do this to have security over accessing the memory contents of the storage medium, as is conventional in the art, while also providing a storage medium that is small and convenient.

4. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimazaki et al. (US 2002/0060969) in view of Opheij et al. (cited in previous Office Action).

Shimazaki et al. teaches an IC/chip card (paragraph [0016]) having a width, length, and thickness. Though Shimazaki et al. is silent to the ratio of the length to thickness being at least 5:1, the Examiner notes that it appears the card fulfills that ratio (FIG. 8A), and the Examiner additionally notes that such sized IC/chip cards are well known and conventional for convenience/portability, and therefore would be an obvious expedient. Though silent to a storage medium, the Examiner notes that it is well known and conventional for IC/chip cards to have an associated memory to store information. Shimazaki et al. teaches the storage medium on the card is a disk, and that the card has a shutter that moves back and forth to provide access/opening to the disk (FIG. 1). Though Shimazaki et al. is silent to a pin on the card to move along directions to open and close the opening, Shimazaki et al. teaches a shutter 132 for

opening and closing the head insertion opening 132. Similar to that of a floppy disk, it is obvious that the shutter opens to be read, and closes when not read. Though silent to a pin on the card, the Examiner notes that typical shutters including sliders/engaging members to facilitate opening and closing motion of the shutter. Accordingly, it would have been obvious to use a pin, as a means to facilitate movement of the shutter, including opening and closing it by moving the pin/moving means in different directions.

Shimazaki et al. is silent to the IC including security information, that the security information is used to authenticate an access request to the storage medium.

Opheij et al. teaches a card with a storage medium to store data (3), an integrated circuit device including security information (2,20 that include security information (PIN)), both the storage and IC provided within the card (FIG. 1B), wherein the security information stored in the IC is used to authenticate an access request to the storage medium. It is understood that the PIN is used to authenticate an access request to the storage medium.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art combine the teachings of Shimazaki et al. with those Opheij et al.

One would have been motivated to do this in order to provide security to the stored information on the medium.

Additional Remarks

5. The Examiner notes that it is well known and conventional to store security information in an IC to authenticate access to the storage medium (see US 6,776,346 and US 6,578,768).

Additionally, US 6,669,100 which teaches a reader with a processor to authenticate an

authorization request and (interpreted as a security module), and US 6,484,940 which teaches a sheath that opens and closes to access the storage medium of the card. The Examiner notes US 2002/0180060 teaches a chip stacked directly above flash memory, US 2003/0209793 teaches a chip mounted over the memory chip, as does US 2001/0015485.

Additionally, the Examiner regrets any inconvenience caused by this action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lauinger et al. (US 2005/0081367), Conner et al. (US 2003/0024995 and US 2002/0060969), Weinberger et al. (US 6,021,030), Nishizawa et al. (US 2005/0052924 US 2005/0090129 US 2003/0209793, and US 6,431,456), Sakui (US 2005/0128808), Rowe (US 2005/0124407), Masuda et al. (US 2004/0135262, US 2002/0180060, and 2001/0010397), Song et al. (US 2001/0015485), Wada et al. (US 6,858,925), Chiou et al. (US 2005/0156333), and Son et al. (US 2003/0197261).

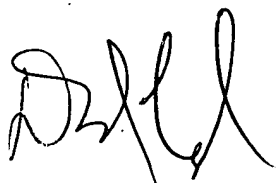
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
8/31/05



KARL D. FRECH
PRIMARY EXAMINER